

REMARKS

Upon entry of the present amendment, claims 1 and 4 will remain pending in the above-identified application and stand ready for further action on the merits.

In the instant amendment, claim 1 has been amended and claims 2 and 3 have been cancelled.

The amendments made herein to the claims do not incorporate new matter into the application as originally filed. For example, claim 1 has been amended to incorporate the features of claim 3 therein. The term "catalytic amount" is supported by the specification at page 3, last full paragraph, and pages 8 and 9 of the specification. Claims 5-7 are supported by the disclosure on page 7 of the specification.

Proper consideration of each of pending claims 1 and 4 is respectfully requested, as is entry of the present amendment.

Information Disclosure Statement

Applicants appreciate the Examiner's comments set forth at page 2 of the Office Action concerning the IDS filed on October 20, 2004.

Further, Applicants note that an initialed PTO-1449 form has not been received for the IDS filed on February 26, 2004. The

Examiner is respectfully requested to return the initialed PTO-1449 form to the Applicants in the next communication.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lloyd (GB 1,200,730). (At page 2 of the Office Action, though Lloyd was identified to be US patent 1,200,730, it is believed to be GB 1,200,730.)

Reconsideration and withdrawal of this rejection is requested based upon the following considerations.

The Present invention and its Advantages

The present invention relates to a process for producing a specific allyl-containing compound comprising the step of reacting a specific allyl ester compound with a specific compound in the presence of an iridium compound. As stated in Applicants' specification, iridium is the preferred transition element (page 5, line 6). A given transition metal element compound, such as an iridium compound, can be used either alone or in combination with other transition metal element compounds.

The method of the present invention can provides the target compound, for example, in a good yield.

Distinctions over Lloyd (GB 1,200,730)

Applicants have amended claim 1 to specify a transition element compound to be an iridium compound. Upon careful review of Lloyd '730, it is clear that Lloyd '730 neither discloses nor suggests "the presence of an iridium compound".

Lloyd '730 discloses at page 1, lines 27-31:

The Group VIII metals are iron, cobalt, nickel, platinum, palladium, iridium, rhodium, ruthenium and osmium. Preferably the Group VIII metal is a Group VIII noble metal, especially palladium.

However, in this disclosure, Lloyd '730 merely and generally exemplifies all elements belonging to the Group VIII metals. That is equivalent to simply stating "the Group VIII metals". Further, in the working Examples (page 3, line 72-page 4, line 97), Lloyd '730 discloses only the use of palladium, but fails to disclose the use of iridium.

Further, Lloyd states "*Preferably the Group VIII metal is ... especially palladium*" (page 1, lines 30-31). Thus, Lloyd '730 "teaches away" from the present invention.

Accordingly, Lloyd '730 fails to teach and suggest, and rather teaches away from, the requirement of "in the presence of an iridium compound" when discussing the production method, and thus provides no motivation to those of ordinary skill in the art that would allow them to arrive at the present invention.

As the MPEP directs, all the claim limitations must be taught or suggested by the prior art to establish a *prima facie* case of obviousness. See MPEP § 2143.03. Since Lloyd '730 neither teaches nor fairly suggests "in the presence of an iridium compound," as presently claimed, a *prima facie* case of obviousness cannot be said to exist. As such, withdrawal of the rejections of claims 1 and 4 is respectfully requested.

Claim 1 of Lloyd '730 generally discloses a process for the production of olefinic compounds which comprises contacting a vinyl or allyl ester with a nucleophilic reagent of formula HA, in which H is hydrogen and A is a nucleophilic element or group, in the presence of a Group VIII metal and a salt of copper, iron, cobalt, nickel, tin or lead. As explained above, Lloyd '730 fails to specifically disclose and teach the use of an iridium compound. Further, for example, in Example 9, allyl acetate, which is used as an allyl ester, and hydrogen chloride and water, which are used as HA, are used to obtain allyl chloride, allyl alcohol, and diallyl ether as the main product. Thus, Lloyd '730 discloses the teaching of the use of palladium and some salts of metals in order to obtain olefinic compounds.

In contrast, according to the present invention, the specific allyl-containing compound can be obtained, using an

iridium compound, in good yield, even in the case where such a salt is absent in the production method.

Therefore, the cited art does not provide any motivation to arrive at the instant invention as claimed, and moreover the instant invention possesses unexpected and advantageous properties not rendered obvious by the cited art.

Accordingly, upon consideration of the instant amendments to the claims, it is clear that the Examiner's rejection under 35 U.S.C. § 103(a) over Lloyd '730 has been overcome. In this respect, the cited art does not provide any motivation to arrive at the instant invention as claimed, and moreover the instant invention possesses unexpected and advantageous properties not rendered obvious by the cited art.

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance indicating that each of the pending claims 1 and 4 are allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond C. Stewart (Reg. No. 21,066) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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